

DISCUSSION OF THE AMENDMENT

Claim 1 has been amended by incorporating the subject matter of Claim 5 therein;
Claims 3-5 have been canceled. In addition, various grammatical errors have been corrected.

Claim 6 has been amended to depend on Claim 1. Claim 9 has been amended from plural to singular format.

No new matter is believed to have been added by the above amendment. Claims 1, 2, and 6-11 are now pending in the application.

REMARKS

The rejections of Claims 1-11 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over, and of Claims 5-6 and 9-10 under 35 U.S.C. § 103(a) as unpatentable over, US 2002/0102198 (Kuhlmann et al), are respectfully traversed.

As recited in above-amended Claim 1, an embodiment of the present invention is an amorphous silica particle having a maximum value of $\Delta V_p/\Delta R_p$ of $20 \text{ mm}^3/\text{nm}\cdot\text{g}^{-1}$ or more in a pore distribution curve obtained by a benzene adsorption isotherm, wherein V_p is a pore volume [mm^3/g] and R_p is a pore radius [nm]; **a pore peak radius of from 20 nm to 100 nm when the $\Delta V_p/\Delta R_p$ value is maximum**, and an oil absorption of more than 300 ml/100g (emphasis added).

Kuhlmann et al discloses a process for making precipitated silicas having a DBP absorption value of more than 380 g/100 g [0012], which process, according to the Examiner, combines sodium silicate and sulfuric acid, wash and filter the precipitate, and add acid to adjust pH values. The Examiner finds that the process disclosed by Kuhlmann et al is substantially similar to the process disclosed in the specification herein for making the claimed amorphous silica particle. The Examiner thus concludes that the silica of Kuhlmann et al would be expected to also be substantially similar and have substantially similar properties.

In reply, the newly-submitted Panz Declaration reproduces Reference Example 1 and Reference Example 2 of Kuhlmann et al, labeled as Silica 1 and Silica 2, respectively, except that while these reference examples were run on a production scale, the Declaration examples were carried out on a pilot plant scale. The physico-chemical data, as described in the Panz Declaration, is similar to the values disclosed for said Reference Examples 1 and 2 in Kuhlmann et al. The differences can be attributed to the differences in scale. The Panz

Declaration shows benzene absorption curves for Silica 1 and Silica 2. As concluded by Panz, the silicas according to Kuhlmann et al do not exhibit peaks in their pore size distribution curves for pore radii in the range of from 20 to 100 nm. Accordingly, the presently-claimed silicas are different from those that result from the processes disclosed by Kuhlmann et al. Nor are the presently-claimed silica particles otherwise unpatentable over Kuhlmann et al, since Kuhlmann et al discloses and suggests nothing with regard to peaks in pore size distribution in the pore radius range of from 20 to 100 nm.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 1-4 and 7-11 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over US 5,922,298 (Boyer et al), is respectfully traversed. Boyer et al discloses an amorphous precipitated silica having, *inter alia*, a DBP oil absorption in the range of from 180 to 300 cm³/100 g, preferably 180 to 260 cm³/100 g (column 4, lines 10-14). Indeed, the present claims now contain the limitations of Claim 5, not subject to this rejection. Accordingly, it is respectfully requested that the rejection be withdrawn.

The provisional rejection of Claims 1-11 on the ground of nonstatutory obviousness-type double patenting over Claims 1-7 and 9-116 [sic] of copending Application No. 10/567,082 (copending application), is respectfully traversed. The copending application is now US 7,488,533 (patent). **Submitted herewith** is a terminal disclaimer over the patent. Accordingly, it is respectfully requested that the rejection be withdrawn.

Application No. 10/566,373
Reply to Final Office Action of January 15, 2009

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon



Harris A. Pitlick

Registration No. 38,779